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PATENT
Docket No. 356972020100

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Date: December 16, 1998 Signature: amello
Annette M. Mello

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

SUGIHARA, et al.

Serial No.: 08/913,811

Filing Date: September 24, 1997

For: METHOD FOR MEASURING PHYSIOCOCHEMICAL PROPERTIES OF TISSUES OR CELLS, METHOD FOR EXAMINING CHEMICALS, AND APPARATUS THEREFOR

Examiner: C. Spiegel

Group Art Unit: 1641

RESPONSE TO RESTRICTION REQUIREMENT

Box Non-Fee Amendment
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is communication is in response to the Office Action dated July 17, 1998.

The Examiner is reminded that the requirement for "Unity of Invention" in a national application taken out of a PCT application is examined using somewhat different rules. The Examiner is reminded of the decision in *Caterpillar Tractor Co. v. The Commissioner of Patents and Trademarks*, 231 U.S.P.Q. 590 (E.D.Va. 1986). To quote MPEP §1850,

> "Therefore, when the Office considers international applications as an International Searching Authority, as a International Preliminary Examining Authority, and to national stage applications under 35 U.S.C. §371, the Examiner should consider for unity of invention all the claims to different categories of the invention in the application and permit retention in the same application for searching and/or

preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2."

The section goes on to say that Annex B of the PCT administrative instructions as found in the MPEP at AI-38, and following, shows various examples concerning unity of invention.

Before delving into the details of the common technical feature, it should be observed that neither of the International Searching Authority nor the International Preliminary Examining Authority entered a Unity of Invention objection against this set of claims. Consequently, it is singularly inappropriate that the national phase examiner begin to do so now.

Nevertheless, the common generic "special technical feature" involves the steps of measuring the physical and chemical properties of the tissue or cell, changing the physical and environment in the environs of the tissue or cell, and then remeasuring the physical and chemical properties of the tissue or cell. This concept is found in the method found in independent claim 1, the device found in independent claim 5, the more specific method found in independent claim 12, and the device found in independent claim 13. In view of the presence of this common technical feature, it is submitted that the restriction requirement is improper and should be withdrawn.

Because of *Caterpillar v. The Commissioner*, it is believed that 37 C.F.R. §§1.141 and 143 are not appropriate measures. Nevertheless and ONLY in an abundance of caution, Applicant elects the invention of Group III with traverse, for the reasons mentioned above. It is further submitted that because this is a national phase application brought out of PCT, that the reasons that the Examiner forwards as appropriate, e.g., "separate status in the art," "divergent and different search areas," and "device functional compatibility . . . ," are wholly irrelevant in determining whether or not a common technical feature is employed in the claims. It should be apparent that if the Applicant is required to show that a common technical feature is present amongst the claims in this practice, the Examiner must disprove the presence of a common technical feature as well.

Withdrawal of the restriction requirement is therefore requested and examination of all the claims is therefore now appropriate.

Should the Examiner have any further questions, comments, or requests, she is invited and urged to contact Applicant's attorney at the number listed below.

Respectfully submitted,

Dated: December16, 1998 By: _____

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